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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/714,441 06/13/91 BURTON

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L
EXAMINER

DAUS, D

ART UNIT PAPER NUMBER

122
DATE MAILED:

10/07/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-42 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-42 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Art Unit 122

Odorisio "B" wasn't seen in the file and accordingly, isn't initialled. It will be if, a(nother) copy is provided.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

Paragraph 8 appears inconsistent with the "reviewed and understand the contents" of the specification in the ^{USQa\} declaration (Applicant is advised that the patent file is unavailable. Does the applicants appreciation declaration so recite?).

Paragraphs 9, 12 don't recite the circumstances, date, when/how applicant discovered the inoperability.

Paragraph 16 doesn't state how the "missing" "O" in claim 26 came about. Was it in the original claim? A copy is requested.

Paragraph 18 doesn't recite how or when applicant discovered P Bv 3 "does not appear to work".

The ~~Odenb~~ueller declaration, par. 10, states a lack of awareness of the EP search report, identifying Kim and Baranaukas and Shepard (all not listed as record in the parent prosecution) as "Y" references, although addressed to ^a(~~Not~~her) patent counsel of applicants' assignee, in July 1988. Shepard was known, in 110 181 before Sept. 1988. Reissue is denied those who are aware of an (almost) anticipation, but take out the patent anyway. Cf In re Clark 187 USPQ 209. Notice to a counsel (MsHogen) is noted ^{ice}

Art Unit 122

imputed to assignee. The record is incomplete in that there appears no averment from Mr. Montgomery whether he was aware of the EP search report. His awareness would be imputable and pertinent to the Clark issue. Neither declaration recites when or how or by whom the EP search report was discovered. Dr. Burton states "April 1991", but not how. Par. 11 of Odenweller declaration states the assignee's (but not a particular person's) "subsequent review" - resulted in instant reissue. The record is devoid of facts concerning this review and is insufficient declaratory basis upon which reissue may be granted.

Claims 1-42 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

Claims 1, 8-14, 18-20, 24-6, 32-4, 38-9, 41-42 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6 ↓
1. (Claims 1, 8-13, 18-19, 24-6, 32-34, 38, 42) Since applicants, in SN. 487,880 (cip of SN. 110,181, identified in the Odenweller declaration, unavailable to the Examiner) teaches phenolic hydroxyls react with PCl_3 (at least in the presence of

Art Unit 122

traces of organic amine e.g. structure IV), No enabling teaching "how to make" products having a free hydroxyl is described in the instant specification, (Par. 1).

2. (Claims 1, 8-13, 18-9, 24-6, 38, 32-34, 42). Specification, Col. 15, lines 17-58 admits phenolic hydroxyls react with PC13. No enablement is described for claimed products having a free phenolic hydroxyl, e.g. on R¹, R1, R2 and R, or Formula IV (Par. 1).

3. Claim 9, not dependent in claim 1, doesn't recite the new definition ~~don't~~ of A added to claim 1. ~~It~~ Is this intended? Exparte IONESCU ~~U~~. 222 USPQ 537, 539-40. (Par. 2).

OK 4. Is graphite or coal intended for "polynuclear" A in claims 9-11, 25, 33, 42? (Par. 2) Term is nonlimiting/indefinite.

OK 5. In claim 1, line 2 after Formula II "substituted" is singular, the verb "are". Is plural intended?

OK 6. Is "substituents" intended? (Par. 2). 6. (Claims 1, 8-13, 18-19, 24-6, 32-4, 38, 42). How do halogens as I, Br, (or even (Cl) survive the reaction with "Fluorinating agent" without being displaced by F. SF₃ would be expected to displace I, etc. How is this avoided? (Par. 1). Do applicants intend F for "halo"? (Par. 2).

7. Claims 1, 8-14, 18-20, 24-26, 32-4, 38-9, 41-2). What is intended by "aryl"? anthracene? Perylene? Diphenyl? Exparte IONESCU 22 USPQ 537, 539-40. (Where aryl is further substituted

Art Unit 122

by phenyl, the latter meaning may render claims indefinite from double inclusion of element. *Exparte White* 127 USPQ 261. (Par. 2). Specification provides no guidance (Par. 1).

8. What is an aryl of 12 carbons? biphenyl? 11 carbons? biphenyl? 7 carbons? 8 carbons (cyclooctadiene?) (Par. 2) specification provides no guidance (Par. 7).

OK 9. Claim 32 is improperly dependent, not being embraced by claim 8 when "containing" was ~~detected~~. (Par. 2).

10. Sources of the newly inserted A structures of claim 1, and claim⁹ are not provided in the specification, *Exparte Moersch* 104 USPQ 122 (Par. 1).

11. Sources of R as substituted aryl, i.e. perylene, benzopyrene on the "aryl", or R¹, R₂ on the "aryl" or R¹, R₂ with octadecyloxy carbonyl ethyl substitution on the aryl aren't seen but are required, Moersch In re Howarth 210 USPQ 684. Absent sources, the public¹ offered mere language rather than enablement particularly at the point of novelty (Par. 1). It appears inconsistent to urge non obviousness over the art, on the basis of these substituents, but that these substituents sources needn't be provided because they are within the skill of the art. (Par. 1) copies of the pertinent documents in Col. 16 relied on are requested to complete the record.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

Art Unit 122

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 2, 8, 9 are rejected under 35 U.S.C. § 102(b and g) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shepard '506. Col. 1, lines 14-30 disclose a subgenus of instant formula V except that R therein is a small 5 membered group (OH and halo). See ~~a small 5 membered~~ Claim 1. They are taught for the same purpose, "antioxidants, stabilizer,"

Art Unit 122

Col. 1, line 31-2.

Shepard reacts phenols with Phosphorous trihalides, (See Claim 10) mentioning phosphorous ~~tr~~ifluoride at Col. 4, line 21, and amines, line 26. The particular phenol of Claim 2 is at Col. 3, lines 1-5. Table 1 indicates chloro analogs are quite stable.

Instant compounds V are in possession of the public for the same purpose. In re Schaumann 197 USPQ 5.

Claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Kulakova.

CAS online reports registry No. 2, 27, 88-91-6P wherein, Formula 111, R is unsubstituted aryl, and R₃ is methyl is in Kulakova.

Claims 1, 8, 9 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Baranauck~~as~~ et al.

Claim 5 reacts a methylidinediphenol with PX₃, Monohalo ^{II} formula VI compounds being formed in situ as the second halo is added. Claim 2 is a narrow class embracive.

The narrow class of 4 halogens is an anticipation of any one of them. In re Petering 133 USPQ, Schaumann~~g~~. Example 3 mixes the compounds into a resin.

Claims 1, 8-11, 24, 32-3 are rejected under 35 U.S.C. § 102(b and g) as anticipated by or, in the alternative, under 35

Art Unit 122

U.S.C. § 103 as obvious over Spivak '207. Spivak Claims 11-12 are to polyolefin polymers stabilized with 0.01 to 5% of commonly embraced subject matter in claim 1.

Spivak Claim 1 has formula III type compounds, where P can be substituted by halo, the aryl being substituted by alkyl, benzyl, etc.

F is embraced, although not preferred. The stabilizer of Claim 1 may be mixed with the polymer in dry powder form (Cl. 9, lines 12-13) or as a solution (line 15).

Claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Spivack 855.

Col. 13, lines 35-40 teaches a subgenus where R is halogen, Cf being 1/4 of such genus of Formula V and VI.

Claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Kimer USSR. Page 1, lines 1-9 teaches structure V and VI halo compounds, F representing 1/4 of the possibilities. Page 3 teaches Formula III structures, for use in polymers.

Claims 1-3, 6, 8-42 are rejected under 35 U.S.C. § 103 as being unpatentable over Spivack '207 in view of Razumova, Kullkova, Schmutzler, Ivanova, Shepard. Spivack and Shepard are applied as above, Razuma, page 162, second full paragraph, Kulakova compound VIII, Schmutzler page 2446, penultimate and

Art Unit 122

antepenultimate compounds, Ivanova, Table I and II, p. 853 and Schepard render Spivak's suggestion enabling by providing the unsubstituted aryl compounds.

One would expect these F compounds or ~~with~~ substituents ^{taught} ~~aryl~~ by Spivak, to be useful for Spivack's purpose.

Claims 8-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 4,867,907 ~~in view of the~~ '907 claimed compositions of compounds and water are intended to be mixed/sprayed into organic compositions.

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 4,867,907 ~~in view of the~~ ^{In} '907 compositions are instant compounds and water, normally considered patentably indistinct. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Attention is invited to Babullis, Col. 3, line 5, that the compound be used "is available from Ethyl". Was it on sale? When?

Serial No. 07/714,441

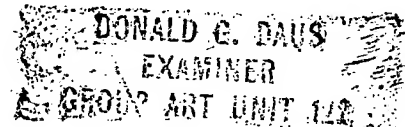
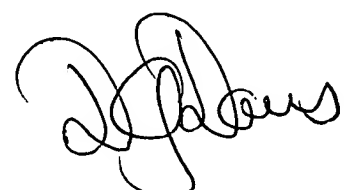
-10-

Art Unit 122

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Daus whose telephone number is (703) 308-4720.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Daus: ach
October 03, 1991



DONALD E. DAUS
EXAMINER
GROUP ART UNIT 112